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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,010	05/23/2001	Clay T. Whitehead	3813-3 (AMK)	7263

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NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER	
GARG, YOGESH C	

ART UNIT	PAPER NUMBER
3625	

MAIL DATE	DELIVERY MODE
06/04/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/863,010	WHITEHEAD, CLAY T.	
	Examiner	Art Unit	
	Yogesh C. Garg	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 April 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7-9,12,14-16 and 18-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5, 7-9, 12, 14-16 and 18-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/4/2008 has been entered.

Response to Amendment

2 Applicant's amendment filed on 4/4/2008 is entered. Claims 1, 14, 21 and 22 are amended. Claims 6, 10, 11, 13 and 17 were previously withdrawn. Currently claims 1-5, 7-9, 12, 14-16 and 18-22 are pending for examination.

Response to Arguments

3. Applicant's arguments filed 4/4/2008 have been considered but are moot in view of new grounds of rejection necessitated due to current amendments.

4 Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific

limitations within the individual claim, other relevant and related passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the other relevant and related passages and figures in the cited references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5, 7-9, 12, 14, 15, 16, 19-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 1-5, 7-9, 12, 14, 15, 16, 19-20, as best understood, it appears that the claimed method steps could simply be performed by mental process alone and are not statutory. The following passage comes from In re Comiskey, 499 F.3d 1365, 84 USPQ2d 1670 (Fed. Cir. Sep. 20, 2007):

> It is thus clear that the present statute does not allow patents to be issued on particular business systems—such as a particular type of arbitration—that depend entirely on the use of mental processes. In other words, the patent statute does not allow patents on particular systems that depend for their operation on human intelligence alone, a field of endeavor that both the framers and Congress intended to be beyond the reach of patentable subject matter. Thus, it is established that the application of human intelligence to the solution of practical problems is not in and of itself patentable.

The independent claims 1 and 6 are directed towards steps of “compiling a user profile”, “accessing a database”, “providing the user with an option”, “automatically accepting”, “communicating the relevant items”, etc.. Since the claims are directed to a

process (i) without transforming underlying subject matter (such as an article or materials) to a different state or things and (ii) without including another statutory class of invention (i.e. machine, manufacture, or composition of matter), these claims fall within the scope of human intelligence alone, and are non-statutory.

If the independent claims 1 and 14 are amended using [mere suggestions only] machine/processor/computer network system or necessary hardware and software in compiling the profile, accessing a database, providing the user with an option, automatically accepting, communicating the relevant items then this rejection could be withdrawn.

Claim Rejections - 35 USC § 112

6. Claims 1-5, 7-9, 12, 14-16 and 18-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter , "wherein only a user and not a vendor complies the profile", which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the arguments filed 4/4/2008 the applicant argues that this added limitation is supported by the applicant's disclosure (see page 10) but the examiner respectfully disagrees because none of the paragraphs 0007, 0009, 0029, 0031, 0032 and 0033, as pointed by the applicant do not state that a user's profile is compiled only by the user and a vendor does not compile the user's profile.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 7-9, 12, 14-16 and 18-22 rejected under 35 U.S.C. 103(a) as being unpatentable over Herz in view of Gerszberg et al. (US 2002/0033416 A1), hereinafter Gerszberg and further in view of Dunaway Jr. (US PG-Publication 20020026363 A1), hereinafter Dunaway Jr..

Regarding claim 1, Herz in view of Gerszberg in view of Dunaway Jr. teaches a method for administering consumer items over a global network, the method comprising:

(a) compiling a user profile relating to desired consumer items (see at least Herz paragraph 002, "……*The system automatically constructs and updates profiles of a plurality of shoppers based on their demographics and their history of shopping behavior, which history includes both their purchases and their requests for, or reactions to, product information…….* ",). Herz does not teach that the user's profile is compiled by the user only. However, in the same field of endeavor, teaches that a user's profile such as list of his preferences or wish list is compiled by the user only and not a vendor and this user profile is used in providing products to the user [see at least paragraph 0126]). In view of Gerszberg, it would be obvious to of an ordinary skilled in the art to have modified Herz to incorporate the

Gerszberg teachings of compiling a user's profile such as an user's wish list of items by the user only because, as stated in Gerszberg, it would most help/benefit the user in receiving his most favorite products/brands.

(b) accessing a database of items available from product and service providers and identifying relevant items according to user profile, the relevant items being those that most benefit the user (see at least paragraph 0024, " *The primary functions of the system for the automatic determination of customized prices and promotions 100 are (1) to identify offers that are appropriate for each shopper, (2) to help the shopper become informed about these available offers, and (3) to facilitate any or all of the necessary transactions, such as electronic ordering or payment, if the shopper decides to accept an offer. The present system for the automatic determination of customized prices and promotions 100 concerns functions (1) and (2). In order to carry these functions out,* ***the main computer 101 has access to databases of information about possible offers (offer database 122),*** …… " . Note: The offer database 122 corresponds to the claimed database in the applicant's claim).). Herz also suggests that the relevant items identified are the one that most benefit the user (see at least paragraph 0024, " *The primary functions of the system for the automatic determination of customized prices and promotions 100 are (1) to identify offers that are appropriate for each shopper, (2) to help the shopper become informed about these available offers,…".* Herz disclosure teaches selecting items according to user profile which are appropriate and as analyzed above would correspond to his wish list, that is the items that would benefit the user most as per the compiled wish list.

Herz teaches automatically informing the best offers based upon a shopper's profile and the offers stored in the offer database (see at paragraphs 004, ….. *The system automatically constructs product offers tailored to individual shoppers, or types of shoppers, …* ***These offers are typically represented to the shoppers in digital form. They are communicated ……. or to***

an on-line computer shopping system that directly makes such offers to shoppers. The shoppers can be in the market for any type of product or service, including but not limited to: retail products, financial services, professional services, and the like. " and 0024, " ***The primary functions of the system for the automatic determination of customized prices and promotions 100 are (1) to identify offers that are appropriate for each shopper, (2) to help the shopper become informed about these available offers, and (3) to facilitate any or all of the necessary transactions, such as electronic ordering or payment, if the shopper decides to accept an offer***. ….. *In order to carry these functions out, the main computer 101 has access to databases of information about possible offers (offer database 122),* …… ". See also paragraphs 0005, 0010 and 0246. Paragraph 0246 discloses that even if the offers database does not include the automatic best choice requirement for the user the system communicates a single best possible offer for Crest tooth paste for the user's selection and Crest tooth paste is not part of the user's preferred choices.). Herz/Gerszberg does not explicitly teach the steps (c) providing the user with an option to incorporate in the user profile an automatic best choice service, (d) if the user profile incorporates the automatic best choice service, automatically accepting the relevant items without user intervention, and communicating the accepted relevant items to the user, and (e) if the user profile does not incorporate the automatic best choice service, communicating the relevant items to the user, and enabling the user to selectively accept the relevant items. Dunaway Jr. in the field of online data processing implemented system and method for providing remote culinary preparation Services teaches the above missing steps (see at least paragraphs 0012,"..*For the few clients that prefer not to interact with the website,* ***a manager can set their profile for automatic menu selection.*** " and paragraph 0058, " ***The Client Website Area 700 is also designed to accommodate clients that want to quickly select menus for weeks in advance and***

clients who enjoy browsing and exploring the menu selections. For the few clients that prefer not to interact with the Client Website Area 700, a manager can set their profile for automatic menu selection. ". Note: Dunaway Jr. explicitly teaches providing an option to user to include automatic menu selection based upon the user's profile for the culinary services for a particular user who is not interested in interacting with the web site and selecting menus on their own and conveying those automatically selected menus to the users . The automatic menu selection service provides the optimum/best available menu selection keeping in mind such profile restrictions that is low sodium requirement and the user is diabetic [see Fig.8B]. The users who do not opt for this automatic selection option are provided list of menu selections enabling them to selectively pick/accept the relevant menu items/selections. In view of Dunaway Jr. it would be obvious to one of an ordinary skilled in the art to modify Herz/Gerszberg to incorporate the steps (c) providing the user with an option to incorporate in the user profile an automatic best choice service, (d) if the user profile incorporates the automatic best choice service, automatically accepting the relevant items without user intervention, and communicating the accepted relevant items to the user, and (e) if the user profile does not incorporate the automatic best choice service, communicating the relevant items to the user, and enabling the user to selectively accept the relevant items because it satisfies both types of consumers (a) who want a quick response without having to interact with the server website for item selection and (b) who want to interact, browse and select items themselves.

Regarding claims 2-3, Herz/Gerszberg discloses that the step (a) in claim is practiced by monitoring a pattern of consumer's item use or user-entered parameters (see at least paragraph 005, " *Largely by tracking the behavior of shoppers, the system accumulates extensive profiles of the shoppers and the offers that they consider. The tracking can comprise a number of sources of data to thereby utilize multiple attribute clustering to provide a more powerful analysis capability. ……. As explained in the U.S. Pat. No. 5,758,257, shoppers can be profiled in terms of both their demographic characteristics (age, income, family structure, ethnicity, and the like) and their past shopping behavior (products purchased, length of time since last purchase, allocation of browsing time, attention span, price sensitivity, interest in detailed features, impulse buys, use of coupons, and the like). Offers can be profiled as well. ….. the shoppers who tend to buy the product, other products frequently bought on the same shopping trip, the sales pitch, the price and terms of payment, any discounts provided, and the relative attributes of competing offers.* …… ". Also see paragraphs 0021-0024.Note: Tracking shopper's purchasing behaviors and the products purchased by them using computers, etc. reads on the limitations of claims 2-3. As regards the limitation that the items are user-entered parameters the wish list is entered by the user himself.)

Regarding claim 4, Herz discloses periodically repeating steps (b)-(e) (see at least paragraphs 0300-0301, "……*By decomposing purchase patterns for various product groups across different frequency ranges, we can learn more about seasonal buying behavior. It may turn out that a certain group of shoppers receives their paychecks exactly once a month. This group would clearly be a target for impulse purchases or slightly more expensive items, as they have more cash to spend at that time…..Time series methods are also useful for detecting trends; one could do a linear regression on sales for a certain product over time, determining the overall direction of a product's sales. This information could be used to adjust offer-generating strategies, as it would indicate a waxing or waning of*

a customers overall interest in a given product. ". Note: Contemplating to target shoppers every month when they get their paychecks corresponds to periodically repeating steps (b)-(e) of claim 1.

Regarding claim 5, Herz teaches that the relevant items are identified based on a lowest cost consistent with the user profile (see at least paragraph 0036, " *Determine Shopper's Goals--Optionally, the shopper may indicate a particular type of offer in which he or she is interested--for example, large-sized, mail-order dress shirts* ***costing under $30****. ...* ", and paragraph 0005, " *As explained in the U.S. Pat. No. 5,758,257, shoppers can be profiled in terms of both their demographic characteristics and their past shopping behavior (products purchased, length of time since last purchase, allocation of browsing time, attention span,* ***price sensitivity****,* ").

Regarding claim 7, Herz discloses communicating with users via e-mail (see at least paragraphs 0051, " *Any of the transactions between the main computer and a shopper or shopper's terminal might instead be handled through other means of communication, such as conventional mail,* ***electronic mail****, telephone, and conventional payment systems.* ").

Regarding claims 8 and 9, Herz teaches that the consumer items comprise subscription services (see at least paragraph 0136, " *list of on-line newspapers and magazines subscribed to by shopper (associative)* ") and practicing on a one-time basis to effect a purchase of a particular product (see at least paragraph 0005, " *The system can then select, present, price, and promote goods and services in ways that are tailored to an individual consumer. detailed product information screens can be subtly rearranged, lengthened, or*

shortened from one type of shopper to the next. Furthermore, when a product can be tailored to a particular shopper, a general technique or expert system can offer each consumer an appropriately customized product. …….. ".).

Regarding claim 12, the step of identifying related items available at a low incremental cost separately and communicating identified related items to the user is already analyzed in claims 1 and 5 above. As regards identifying and relating combinations, see paragraphs 0247-0250, " *Joint Promotions …….. The same profiling approach described above can be used to select joint promotions. The basic method is to observe what items are bought by similar customers. For example, purchasers of beer at convenience stores are observed to also tend to purchase chips, pretzels and (less obviously) baby diapers. Such correlations can be noted from users' on-line purchase histories and used to generate joint promotions ("buy a new set of skis and get a free lift ticket at a ski resort") known as data mining. Similarity may be used as a criteria for integrating two or more products into a single promotional offer. ….Also, she really likes getting discounts, and she likes buying in large sizes. Then the system should try to find two large-size products that can be discounted and pitched as healthy, and bundle them together. For example, it might tell her that if she buys a family-size tube of plaque-fighting Crest at 10% off AND a set of three at 10% off, then she'll get an extra dollar off.* " . Note: Joint promotions are directed to combination of related items).

Regarding claims 14-16, 18-22, their limitations are closely parallel to the limitations of claims 1-5, 7-9, 12 and are therefore, analyzed and rejected on the same basis.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Moore et al. (US 7,200, 566 B1, see at least col.3, lines 27-42), and McCollom et al. (US 6,925,444 B1) teach that a user creates his own user profile in the form of wish list which is sued by the merchants/service-providers to supply products/services.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex/Hoteling.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Yogesh C Garg
Primary Examiner
Art Unit 3625

/Yogesh C Garg/
Primary Examiner, Art Unit 3625